

REMARKS

The Office Action of January 29, 2008 has been received and carefully reviewed. It is submitted that, by this Amendment, all bases of rejection and objection are traversed and overcome. Upon entry of this Amendment, claims 38, 40-43 and 45-47 remain in the application. Claim 44 has been canceled herein. Claims 48-58 have been withdrawn. Reconsideration of the claims is respectfully requested.

At the outset, in the Office Action dated February 7, 2007, the Examiner indicated that claims 43-47 will be examined in light of Applicant's arguments presented in their Amendment dated June 1, 2006 contrary to the Restriction Requirement presented in the Office Action of August 14, 2006. As such, Applicants have changed the status identifiers for claims 43-47 from "Withdrawn" to "Previously presented" to reflect that these claims are also pending in the instant application. Claims 48-58 remain in the application as withdrawn.

The Examiner objects to the Abstract of Applicants' application as filed. The Examiner states the Abstract contains the legal phraseology of the term "comprising" and has not been limited to a single paragraph.

A new Abstract is provided herein and intended to replace the one in Applicant's application as filed. The new Abstract excludes any legal phraseology and/or similar terms, and is limited to a single paragraph. In view thereof, Applicants submit that the Examiner's objection to the Abstract has been obviated, and withdrawal of the same is respectfully requested.

Claims 38 and 40-47 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lever, et al. (EP 0458481), in view of Ellery, et al. (US Patent No. 5,631,078). The Examiner submits that Lever teaches almost all of the elements of independent claims 38 and 43, and admits that Lever does not disclose that the film or sheet is **paper**. The Examiner relies on Ellery to supply this deficiency; namely that Ellery teaches **a film** having paper that is conventionally made using cellulose ester fibers. The Examiner concludes that the combination of Lever and Ellery renders obvious independent claims 38 and 43.

In response thereto, Applicants respectfully disagree with the Examiner for the following reasons. Independent claims 38 and 43 have been amended to recite "[a] coated **paper** substrate" and "[a] **paper-based** print media," respectively. Claim 38 had previously, and still does recite that the coated substrate includes "**a paper** substrate" (emphasis added). Claim 43 has been amended to recite that the print media also includes "**a paper** substrate" (emphasis added). Support for the recitations in claims 38 and 43 may be found throughout Applicants' specification as filed, at least at page 3, lines 10-12, and in the claims. Claim 44, which depends directly from claim 43, has been canceled in view of amended claim 43.

In sharp contrast to claims 38 and 43, Lever is directed to a polymeric **film** (a component of which may include a cellulose ester such as, e.g., cellulose acetate) including a polymeric substrate selected from a thermoplastic material.

Ellery also teaches a **thermoplastic film**, as admitted by the Examiner. The Examiner relies on Ellery to supply the deficiency of Lever; namely that Lever fails to disclose a **paper** substrate. Applicants submit that Ellery teaches that the **thermoplastic film** is formed **from paper** by combining the paper (i.e., cellulose pulp) with cellulose acetate and a cellulose ester plasticizer and applying heat and pressure. Thus, Ellery is *not* teaching the formation of **paper**; but rather the formation of a thermoplastic film having as **one ingredient** paper (in sharp contrast to claims 38 and 43).

In any event, neither Lever nor Ellery teach or even suggest a coated **paper** substrate or a **paper-based** print media including a **paper** substrate. In Ellery, the thermoplastic film is formed by **converting** the paper into the film. Thus, the product does **not** include paper as a substrate; but rather includes a thermoplastic material as the substrate. (See column 2, lines 3-11 of Ellery.)

It is also submitted that one skilled in the art would not assume that either of the thermoplastic films or sheets of the prior art would work as a paper-based printing surface. This is due, at least in part, to the differing chemical and physical properties of cellulose pulp (present in paper) and cellulose acetate (present in the thermoplastic films of Lever and Ellery). For example, when cellulose acetate is compounded with suitable

plasticizers (such as in Ellery in column 2, lines 3-11)), a thermoplastic product is formed. Such thermoplastic products (which tend to soften when heated, and harden when cooled) are often used in the manufacture of rubber and celluloid materials, as well as in photographic and cinema films. They are not typically used for printing a toner image thereon. If, however, an image is printed on the thermoplastic product, the printing characteristics of the thermoplastic film tend to be different from those of ordinary paper based at least on its chemical and physical structure and thus, the image would come out differently.

For the reasons provided above, it is submitted that the combination of Lever and Ellery *fails* to teach a coated **paper** substrate or a **paper-based** print media including a **paper** substrate, as recited in independent claims 38 and 43, respectively. As such, it is further submitted that Applicants' invention as defined in these claims, and in the claims depending ultimately therefrom, is not anticipated, taught or rendered obvious by Lever and Ellery, either alone or in combination, and patentably defines over the art of record.

In summary, claims 38, 40-43, and 45-47 remain in the application. It is submitted that, through this Amendment, Applicant's invention as set forth in these claims is now in a condition suitable for allowance.

Further and favorable consideration is requested. If the Examiner believes it would expedite prosecution of the above-identified application, the Examiner is cordially invited to contact Applicants' Attorney at the below-listed telephone number.

Respectfully submitted,

DIERKER & ASSOCIATES, P.C.

/Julia Church Dierker/

Julia Church Dierker
Attorney for Applicants
Registration No. 33368
(248) 649-9900, ext. 25
juliad@troypatent.com

3331 West Big Beaver Rd., Suite 109
Troy, Michigan 48084-2813
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JCD/AMS/jo